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EXAMINER

TRAVERS, RUSSELL S

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 06/11/2003 //

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/869,511

Applicant(s)
Bengs et al

Examiner
R.S. Travers J.D., Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 7, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) 1-12, 14, and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3,4 6) ☐ Other: _____

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The amendment filed June 28, 2001 has been received and entered into the file.

Claims 1-15 are presented for examination.

Applicant's election with traverse of Group II claim 13 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that Examiner neither understand unity of invention, nor describes the unique technical feature unifying the instant invention. This is not found persuasive because Examiner fully understands unity of invention (see paper 9, page 2, paragraph 2) and recited those guidelines governing unity determinations from the Patent Cooperation Treaty. To possess unity of invention, a group of related inventions must a special technical feature to unify the disparate claimed inventions. In the instant case, various therapeutic and cosmetic compositions are recited; and a product by process is recited. This product is amylose, no special technological feature was attributed to that amylose recited, save the source. Thus, claim 13 fails to embody a special technical feature linking amylose compounds to those several compositions of matter herein claimed. And therefore lacks unity of invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-12 and 14-15 are withdrawn from consideration as reading on non-elected subject matter.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27, 30 and 31 of U.S. Patent No. 6,562,459. Although the conflicting claims are not identical, they are not patentably distinct from each other because those claims herein recited read on an insoluble linear amylose regardless the degree of branching. The instant claims are not so limited.

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The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApl's 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence or absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art
- 7) the predictability of the art, and

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8) the breadth of the claims.

Applicant fails to set forth the criteria that defines neither what compounds would reside under the “biotechnologically obtained” penumbra, nor what processes would need to be employed to obtain a compound that was “biotechnologically obtained”. . Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these compounds without undue experimentation. In the instant case, only a limited number of compounds which would reside under the “biotechnologically obtained” penumbra, or those processes to be employed in providing a compound that was “biotechnologically obtained”. examples are set forth, thereby failing to provide sufficient working examples. It is noted that these examples are neither exhaustive, nor define the class of compounds required. The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on all what compounds would reside under the “biotechnologically obtained” penumbra, and those processes required to obtain a compound that was “biotechnologically obtained”. , necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation.

Claim 13 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

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Claim 13 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is rendered indefinite by the phrase "biotechnological obtained" and thereby failing to clearly set forth the metes and bounds of the patent protection desired. Criteria defining medicaments that are "biotechnologically obtained" are not set forth in the specification, thereby failing to provide information defining the instant inventions metes and bounds. Applicant's term fails to clearly define the subject matter encompassed by the instant claims, thus is properly rejected under 35 USC 112, second paragraph.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 13 is rejected under 35 U.S.C. § 102(b) as being anticipated by Kossmann et al.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Kossmann et al.

Kossmann et al teach the claimed compounds as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. This medicament is taught as useful for producing various films. Claim 13, and the primary reference, differ as to:

1) recitation of biotechnologically obtained.

The instant claims are directed to employing a biochemical process for obtaining an old and well known compound. Arguments that Applicant's claims are not directed to the old and well known ultimate compound are not probative. It is well settled patent law that a product by process reads on the product. In the instant case Examiner need not reach this ruling. Attention is directed to Kossmann et al, page 25, paragraph 2, setting forth the synthesis of insoluble amylose by employing various immobilized

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enzymes. Possessing these teachings the skilled artisan would have seen the production of the claimed amylose as residing in the skilled artisan's possession.

No claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.

A handwritten signature in black ink, appearing to read 'RTS' or similar, enclosed within a circular flourish.

**Russell Travers
Primary Examiner
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